

REMARKS

In the Office Action mailed October 10, 2010, the Examiner rejected Claims 1-3, 6-8 and 36-40 under 35 U.S.C. §112(1) for lacking enablement, rejected Claims 1-4, 6-9 and 36-40 under 35 U.S.C. §112(2) for indefiniteness, and indicated allowable subject matter. Each rejection is addressed below.

I. Allowable Subject Matter

The Examiner stated:

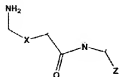
Claims 4, 5, 9, 10 are objected to as being dependent upon a rejected base claim 1, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Applicants now present new Claims 41 and 42 which represent Claims 4 and 5 written in independent form. In addition, the Applicants now present new Claims 43 and 44 which represent Claims 9 and 10 written in independent form.

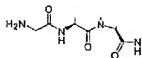
II. Rejection of Claims 1-3, 6-8 and 36-40 under 35 U.S.C. §112(1)

The Examiner rejected Claims 1-10 and 36-40 for lacking enablement. In particular, the Examiner stated:

1-3, 6-8, 36-40 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for few compounds of the elected group wherein X and Z are CONH such that the partial structure of the elected formula I (herein formula



corresponds to



(peptidic backbone) does not reasonably provide

enablement for the large number of structural possibilities claimed for the X and Z variables. See pages 21-25, 66-69. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to **make and use** the invention commensurate in scope with these claims.

The Applicants respectfully disagree. The claims are enabled. The Examiner asserts the application does not provide enablement for the large number of structural possibilities claimed for the X and Z variables and cites the application at pages 21-25 and 66-69. However, one skilled in the art would be enabled to practice the claimed invention as the application displays various X and Y variables within the compounds on pages 21-25 and shows the binding affinities of such compounds on pages 66-69. There would be no undue experimentation required to practice the claimed invention because, upon reviewing the pages relied upon by the Examiner (pages 21-25 and 66-69), one skilled in the art would already have knowledge of various structural possibilities for the X and Y variables. Indeed, given such possibilities, one skilled in the art has the general knowledge to synthesize such compounds, generate pharmaceutical compositions with such compounds, and generate kits as recited in the claimed invention. Accordingly, the Applicants respectfully request withdrawal of these rejections.

III. Rejection of Claims 1-4, 6-9 and 36-40 under 35 U.S.C. §112(2)

The Examiner rejected Claims 1-4, 6-9 and 36-40 as being indefinite. In particular, the Examiner stated:

Claims 1 and dependent claims 2-4, 6-9, 36-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In base claim 1, the orientation of, i.e., connectivity of the bivalent variables X and Z to the rest of the molecule is unclear. Thus, it is unclear of the CONH possibility for X, which part of CONH is linked to the bicyclic system. Is it NH or CO?

The dependent claims do not solve the problem of claim 1.

The Applicants respectfully disagree. One skilled in the art would have no issues with determining how such variables within X and Y would “connect” with the generic molecule. Indeed, one skilled in the art, upon reviewing the application (e.g., pages 21-25) would understand how a particular X or Y possibility (e.g., CONH) would “connect” within the generic molecule such that it fits within standard chemistry practice. The Applicants respectfully request withdrawal of these rejections.

CONCLUSION

All grounds of rejections and objections of the Office Action mailed April 16, 2010 having been addressed, reconsideration of the application is respectfully requested. It is respectfully submitted that the invention as claimed fully meets all requirements for patentability and that the claims are worthy of allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned collect at (608) 662-1277.

Respectfully submitted,

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By: /Robert A. Goetz/

Robert A. Goetz
Registration No. 55,210
CASIMIR JONES, S.C.
2275 Deming Way, Suite 310
Middleton, Wisconsin 53562
Phone: 608.662.1277
Fax: 608-662-1276